

### **REMARKS**

Claims 1-13 are pending in the present application.

Applicant has carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested. No new matter has been added by any of the amendments to the specification. Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

### **WITHDRAWAL OF FINAL OFFICE ACTION**

The Applicant respectfully requests the withdrawal of the Final Office Action on the grounds the Final Action is premature. MPEP § 706.07 provides guidance on when a Final Rejection is proper. In the present case, as explained the Examiner did not provide a proper rejection directed toward claims 6 and 8-10 in the Office Action mailed June 15, 2005. The June 15, 2005 Office Action failed to distinctly point out the limitations as shown in the prior art such that the Office Action fails to achieve the goal set forth in MPEP § 706, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." (emphasis added) The Examiner has stated in the January 9, 2006 Office Action that the "figure following the rejection points out the structural limitations of the claim." In the June 15, 2005 Office Action, the figure following the rejection shows the figures of Lock and identifies a first "slot," a second "slot," and a first "opening." However, the figure fails to identify "a second opening" nor the "first section" and "second section" of the "first opening" as recited in claim 6. Furthermore, nowhere in the June 15, 2005 Office Action does the Examiner explain in words how Lock teaches the limitations of claims 6-10. The Applicant acknowledges that in the most recent Office Action of January 19, 2006, the Examiner has

distinctly pointed out the aspects of the Lock reference that allegedly anticipate the Applicant's invention in paragraphs 10 and 11, and the figure on Page 6. In view of the most recent Office Action, the Applicant has an appreciation of the Examiner's intention in the June 15, 2005 Office Action, but absent the language recited in paragraphs 10-11 of the present Office Action, it was not readily apparent to the Applicant that the figure on Page 6 of the June 15, 2005 Office Action was directed toward claims 6 and 8-10. As such, this is the first practical opportunity for the Applicant to respond to this particular rejection by the Examiner. As such, the Applicant respectfully requests withdrawal of this Final Action and treatment of the action as a Non-Final Action.

### **CLAIM REJECTIONS – 35 U.S.C. § 102**

#### **Claims 1-5**

The Examiner has rejected claims 1, 3-5 under 35 U.S.C. § 102(b) as being anticipated by Skakoon, U.S. Patent No. 5,232,193. The Examiner states:

As to claims 1 and 3-5, Skakoon teaches a tensioner body, the tensioner body having attachment means; holding means; wherein the attaching means and the holding means are collinear; wherein the attaching means comprises an elongated slot through the tensioner body; wherein the holding means comprises a circular opening through the tensioner body; wherein the holding means comprises an elongated slot through the tensioner body.

The Applicant respectfully traverses the Examiner's rejection. First, the Applicant has presented an amendment to claim 1 that the Applicant strongly encourages the Examiner to accept. The Applicant believes the amendment will place the claims 1-5 in condition for allowance.

If the Applicant does not accept the suggested amendments, the Applicant maintains a position that Skakoon fails to teach the tensioner of the present invention. First, the attaching means identified in Skakoon are not "attaching means whereby the tensioner can be attached to a length of surgical tape." In Skakoon, the sheer size of the opening identified would be incapable of serving as "attaching means" as claimed. In this case the phrase "whereby the tensioner can be attached to a length of surgical tape" does result in a structural difference. Surgical tape is a tube, but is just over a millimeter in width and extremely flexible. The tube is designed to

provide a cushioning effect as described in the present application. On the other hand, IV tubing as disclosed in Skakoon is thicker, generally several millimeters and has the rigidity necessary to be used in the Skakoon reference. Therefore, the “attaching means” of Skakoon, while readily useful for IV tubing, is not an “attaching means” for use with surgical tape. For this reason, claims 1-5 are in condition for allowance.

#### **Claims 6-10**

After reviewing the Examiner’s **June 15, 2005**, the Applicant maintains the position that the Examiner failed to distinctly point out where Lock discloses the limitations of claims 6, 8-10. Paragraphs 7 and 8 contain the entire rejection of claims 1, 3-6, and 8-10. Paragraph 9 begins the Examiner’s rejection of claim 9. For reference, paragraphs 7 and 8 read as follows:

Claims 1, 3-6, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Loc Des. 233312.

Lock teaches a tensioner for surgical tape, the tensioner comprising attaching means; holding means; [CLAIM 1] wherein [sic] the attaching means comprises an elongated slot through the unitary tensioner body; [CLAIM 3] wherein the holding means comprises a circular opening through said unitary tensioner body; [CLAIM 4] and wherein the holding means comprises an elongated slot through the said unitary tensioner body. [CLAIM 5]

Accordingly, this response serves as the Applicant’s first opportunity to respond to the Examiner’s rejection.

It is respectfully requested that the Examiner accept the suggested amendments. The amended claims 6-10 are believed to put the claims, and therefore the application in condition for allowance.

#### **Claims 11-13**

The Examiner has rejected claims 11-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,232,193 (Skakoon). Specifically the Examiner stated:

Skakoon teaches a method of clamping, the method comprising the steps of attaching a tension, having a body, to a length of surgical tape; passing a portion of the surgical tape around the elongated body structure; and securing the surgical tape in place by inserting a section of the surgical tape into a gripping portion of the tensioner; wherein the attaching step comprises securing a free end of surgical tape in a slot in the tensioner; wherein the securing step comprises threading the length of the surgical tape through an opening in the tensioner.

It has come to the Applicant's attention that "elongated body structure" should be construed as consistent with "elongated anatomical structure." The term "elongated body structure" has no antecedent basis in the claim language, but if term "body" is construed so as to be synonymous with "anatomical" then it is clear that the Applicant's intention was that "the elongated body structure" be written "the elongated anatomical structure." The Applicant respectfully requests the Examiner adopt the suggested amendment changing "body" to "anatomical." It is believed this amendment will place claims 11-13 in condition for allowance in view of the fact that the prior art cited fails to teach the use of the prior art references with "elongated anatomical structures" such as blood vessels.

**CLAIM REJECTIONS – 35 U.S.C. § 103**

**Claims 2 and 7**

The Examiner has rejected claims 2 and 7 under 35 U.S.C. § 103 over the previously discussed references.

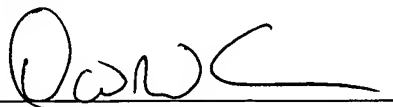
In view of the prior arguments with regard to claims 1 and 6, the Examiner's rejection is now moot. The Applicant now believes claims 2 and 7 are in condition for allowance.

**CONCLUSION**

Applicant has fully responded to the Examiner's rejections. It is respectfully urged that the subject application is patentable over references cited by Examiner and is now in condition for allowance. Applicant requests consideration of the application and allowance of the claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at (972) 367-2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,

By:   
David W. Carstens  
Registration No. 34,134  
Attorney for Applicant

Date: March 9, 2006

CARSTENS & CAHOON, LLP  
P.O. Box 802334  
Dallas, TX 75380  
(972) 367-2001 Telephone  
(972) 367-2002 Facsimile